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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/001,416	11/15/2001	Steven A. Morse	80121-06507	3087

758 7590 08/23/2005

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EXAMINER

THALER, MICHAEL H

ART UNIT	PAPER NUMBER
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3731

DATE MAILED: 08/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/001,416

Applicant(s)

MORSE ET AL.

Examiner

Michael Thaler

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 July 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 12, 13 and 15 is/are allowed.
- 6) ☒ Claim(s) 1-11, 14 and 16-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Claims 11 and 16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 11 is confusing and inaccurate since the endoscope is within the first lumen rather than the second lumen. In claim 16, lines 16-20 are confusing since lines 16-17 indicate that the cannula and endoscope are rotated. However, it is not seen how this rotationally manipulates the operative tip (as recited in lines 17-18) since it is on the endoscopic instrument. Thus, it is unclear what members are stationary and what members rotate.

Claims 1, 2 and 5-7 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Bonutti (5,331,975) for the reasons set forth in the paragraph bridging pages 3 and 4 of the Office Action mailed Nov. 28, 2003. Further, dissection probe 46 is rigid, as claimed, when it is filled with water as indicated in col. 2, lines 24-25 (since water is an incompressible fluid) and since it is made of a substantially inelastic material which provides structural shape to it as indicated in col. 2, lines 37-56. Alternatively, the dissection probe 220 in figure 18A is rigid, particularly when it is "mechanical" as indicated in col. 11, lines 64-68. Alternatively, the dissection probe (the rigid

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plates described in col. 11, lines 60-68) is rigid. Further, dissection probe 46 has a portion eccentric the control rod (e.g. the portion below the axis of the control rod which is larger than the portion above it) and as shown in figures 4 and 5C. As to claim 2, the distal portion of the lumen is clearly a recess as claimed since it receives dissection probe 46 when retracted therein.

Claims 3, 4, 8 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bonutti (5,331,975) for the reasons set forth in the paragraph bridging pages 4 and 5 of the Office Action mailed Nov. 28, 2003. Further, the toroidal shape shown in figure 6 is clearly a substantial loop as claimed.

Claims 9, 11, 14, 17, 18, 22-27 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Bonutti (5,197,971) for the reasons set forth in the paragraph bridging pages 5 and 6 of the Office Action mailed Nov. 28, 2003. Further, the second lumen 116 is clearly for supporting an instrument therein (col. 7, lines 41-43) and, contrary to applicant's remarks near the top of page 19 of the response, it is this instrument, rather than the expandable arms 62 which meet the term "instrument". As to claim 14, the tool or instrument inserted within second lumen 116 may inherently be used for dissection.

Claims 19-21 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bonutti (5,331,975) for the reasons set forth in the first full paragraph on page 6 of the Office Action mailed Nov. 28, 2003.

Claim 16, as best understood, is rejected under 35 U.S.C. 103(a) as being unpatentable over Bonutti (5,331,975) in view of Okutsu (4,819,620) for the reasons set forth in the paragraph bridging pages 6 and 7 of the Office Action mailed Nov. 28, 2003.

Claim 16, as best understood, is rejected under 35 U.S.C. 102(e) as being anticipated by Green (5,928,137) for the reasons set forth in the first full paragraph of page 7 of the Office Action mailed Nov. 28, 2003.

Claims 12, 13 and 15 are allowed.

Applicant's arguments filed July 5, 2005 have been fully considered but they are not persuasive for the reasons set forth above.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action

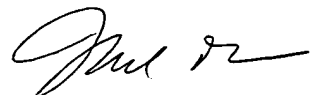
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is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Thaler whose telephone number is (571)272-4704. The examiner can normally be reached Monday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anhtuan T. Nguyen can be reached on (571)272-4963. The fax phone number for the organization where this application or proceeding is assigned is (703)872-9306.

mht
8/8/05


MICHAEL THALER
PRIMARY EXAMINER
ART UNIT 3731